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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/289,044 04/09/99 SOLL

A 1726-001

EXAMINER

TM02/0911

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| | |
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| RIMELL, S | |
| ART UNIT | PAPER NUMBER |

2166
DATE MAILED:

09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/289,044

Applicant(s)

SOLL ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is generally confusing because the second workstation, third workstation program and fourth workstation program have overlapping alternatives, making it difficult to determine what distinction actually exists between these programs, if any. For example:

- (1) Both the second and the fourth workstation programs can receive patient complaints.
- (2) The second workstation can accept "patient symptoms" and third workstation program can accept "vital sign data", which can be the exact same thing.
- (3) The second workstation program can accept "responses to triage questions" and the third workstation program can accept responses to "medical questions" which can be the exact same thing.

If applicant chooses to draft the claims to recite multiple groups of alternatives, then the alternatives should not overlap, otherwise, no distinction can be made between the software groups.

Claim 1 is further indefinite in its recitation of "optional information about patient history from previous visits". It is not clear whether the structure necessary to provide this information is actually part of the invention, or whether it is "optionally" provided.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6 are, as best as can be understood, rejected under 35 U.S.C. 102(e) as being anticipated by Joao ('761).

Claim 1: Joao discloses a first workstation program for accepting biographical and insurance information from a patient (FIG. 9A and col. 16, lines 43-49). A second workstation program accepts information about patient symptoms (FIG. 7A and col. 16, line 57). A third workstation program accepts data on patient vital signs (software receiving data from input devices described at col. 23, lines 51-58). A fourth workstation program can accept the input of a medical diagnosis (software generating a diagnosis at col. 25, lines 30-36). A database server (10) supports the database (10H) which contains all of the collected data on patients and diagnosis made in the past and present. The database server (10) communicates on a network (FIG. 1). The network may include an additional communications server (50). The network of FIG. 1 may be arranged on "any appropriate communications network or system" (col. 15, lines 29-31). This may either be a local area network or the Internet (col. 15, lines 18-47).

Claim 2: Any given workstation which supports the network may include a display terminal (10E and col. 16, line 17); touch sensitive screen (col. 16, lines 9-10); a mouse (col. 16, line 9); a keyboard (col. 16, line 8); and a microphone (audio input device, col. 16, line 11). A workstation with a microphone will inherently include speakers to play the audio output.

Claim 3: The database communications server (10) includes mechanisms (lines of communication as seen in FIG. 1) to communicate with other computer systems).

Claim 4: Col. 20, lines 13-17 outline the usage of statistical data and treatment success and failure rates as a mechanism to refine patient assessment processes.

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Claim 5: FIGS 13B-13C describe a system response analyzer which analyzes submitted insurance data and makes a decision on whether or not an insurance claim is granted or denied. If the claim is denied, the failure to grant payment on the claim is transmitted back to the provider with an opportunity to submit further data (FIG. 13C and col. 35, lines 35-53). Upon the receipt of additional information, the claim is reprocessed.

Claim 6: The denial of a medical claim as described in FIGS. 13B-13C is output indicative of inconsistency. The provider is informed of the inconsistency.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2166